

REMARKS

Claims 61, 64, 66, 68, and 81-88 are pending in the application and are rejected in this Office Action.

Claims 81-82 and 86 are canceled without prejudice.

Claim 61 has been amended to further include plasticizer, nitrocellulose, montmorillonite mineral, and a treated pigment as required ingredients in the composition. Support for the addition of nitrocellulose can be found in the specification at [0065] and claims 81 and 82. Support for the addition of plasticizer can be found in the specification at [0067]. Support for the addition of a montmorillonite mineral and derivatives thereof can be found in the specification at [0061]. Support for the addition of treated pigment can be found in the specification at [0059].

The term benaoates have been removed from claim 61 because of lack of support in the specification.

Rejections Under 35 U.S.C. §103

The Examiner rejects claims 61, 64, 66, 68, and 81 – 88 under 35 U.S.C. §103(a) as being unpatentable over Strella et al. US 3,928,656 (the '656 patent) of record in view of Ohno 5,854,365 (the '365 patent) of record in view of Perronin et al. US 3,991,007 (the '007 patent) of record as evidenced by US 5,798,426 (of record).

The Examiner indicates that Strella discloses a method of developing electrostatic latent images with pressure sensitive toner. The toner comprises 19 parts of an ionic polymer (15.8%), 100 parts of tetrahydrofuran (ether solvent-83.3%), and 1 part Mogul black (pigment-0.8%) (see example 1 and preparation of toner, column 9; see instant claim 61, 64 and 66). The ionic polymer disclosed is butyl methacrylate-acrylic copolymer (94.2/5.8) with a TG of 46 degrees Celsius (see examples II and VIII; see instant claim 61). The Examiner indicated that Strella teaches the use of a pigment or dye such as carbon black, a commercial red, blue, or yellow dye, or any other well-known pigment in an amount of 1-20% (see column 6, lines 4-16); see instant claim 87).

The Examiner indicates that although Strella teaches pigments in the composition, the instant pigments are not specified and that the instant solvents and the inclusion of nitrocellulose are not taught.

The Examiner uses Ohno indicating that Ohno teaches a toner composition wherein the pigment may be carbon black, an aniline black, acetylene black, naphthol yellow, Hansa yellow, rhodamine lake, alizarin lake, iron oxide red, phthalocyanine blue and indanthrene blue in the amount of 0.1-20% (see column 22, lines 25-40; see instant claim 61 and 87).

The Examiner indicates Perronin teaches the preparation of pigmentary particles coated with an organic polymer to allow dispersion of the pigment in a medium. Perronin discusses the importance of pigments in many fields such textiles, plastics, inks, textiles, and cosmetics (see column 1, lines 10-12), the pigment compositions may be advantageously used in numerous fields of application, such as inks, plastics materials, paints, or other colored preparations (see column 4, lines 45-55), examples of monomers which may be used in the process include 1) alkene-mono- or di-carboxylic acids, preferably the acids containing up to five carbon atoms, for example acrylic, methacrylic, etc.; 2) esters of these acids, such as methyl, ethyl, butyl, etc. (see column 3, lines 40-60; see instant claim 61), the pigments used in the composition may be iron oxides and titanium dioxide (see column 2, line 65 to column 3, line 5; see instant claim 61). The solvents may be selected from gasolines, aromatic hydrocarbons such as benzene, toluene, xylene, halogenated hydrocarbons such as trichloroethylene, perchloroethylene, chlorobenzene, trichlorobenzene, chlorofluoromethanes, chlorofluoroethanes, alcohols such as methanol, ethanol, n-propanol, 1-methyl-ethanol, n-butanol, 2 methyl-propanol, 1,1-dimethyl-ethanol, ketones such as 2-propanone, 2-butanone, 4-methyl-2-pentanone, esters such as ethyl acetate, propyl acetate, 1-methyl-ethyl acetate, ethers such as diethyl ether, ethylpropyl ether, tetrahydrofuran, and 1,4-dioxan (see column 2, lines 45-61; see instant claim 61).

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Manual of Patent Examining Procedure 2141.02, 2100-121 -122, Rev. 5, Aug. 2006.

In determining obviousness under 35 U.S.C. 103 the four factual inquiries are:

- (a) determining the scope and contents of the prior art;

- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Often, it will be necessary...to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *KSR Int'l Cp. v. Teleflex Inc.*, No 04-1350 (US Apr. 30, 2007).

Applicant's claim a composition that comprises a pigmented nail enamel mixture of

- (i) a solution of a film-forming addition polymer, of ethylenically unsaturated monomers, in non-aqueous solvent selected from the group consisting of aliphatic ketones, aromatic ketones, aliphatic alcohols, aromatic alcohols, glycol ethers, esters, and
- (ii) 0.1-30%, by weight of the composition, of pigment comprising at least one silicone treated pigment and at least one member selected from the group consisting of D&C colors and FD&C colors and
- (iii) plasticizer, nitrocellulose, and montmorillonite minerals and derivatives thereof, wherein
 - a) the polymer consists of a copolymer of acrylic acid and butyl methacrylate that contains about 2-14 wt.% acrylic acid;
 - b) the polymer has a glass transition temperature in the range of 5 to 90° C;
 - c) the polymer constitutes about 5-95 wt.% of the composition; and
 - d) the composition is suitable for application to human nails.

In this Office Action the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Strella, Ohno, and Perronin and substitute tetrahydrofuran with the claimed solvents such as

isopropanol, ethyl acetate and so on. The Examiner claims that pigments would have been included based on the use of pigments in Ohno and Perronin in compositions comprising polymers. The Examiner believes that Strella's and Perronin's composition is capable of leaving a water-insoluble film on a nail since the compositions are substantially similar.

Applicants previously filed a Declaration under 37 C.F.R. § 1.132 that demonstrates that Strella's composition is not capable of leaving a water-insoluble film on the nail when tetrahydrofuran is substituted with the claimed solvents.

The Examiner ignores that the non-aqueous solvent of applicant's claim consists of aliphatic ketones, aromatic ketones, aliphatic alcohols, aromatic alcohols, glycol ethers, and esters. Instead the Examiner incorrectly claims that the non-aqueous solvent is isopropanol or ethyl acetate (page 3, #6).

Because the Examiner incorrectly ascertained the requirements of applicant's claim the Examiner can't ascertain the differences between the prior art and the claims in issue. This is what is required when the Examiner rejects a claim under 35 U.S.C. 103.

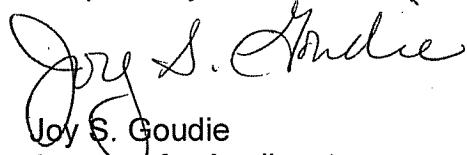
Applicants have amended the claim to require coated silicone pigments. None of the pigments in Strella, Ohno, and Perronin are silicone treated pigments.

The Examiner is required to determine the scope and contents of the prior art and ascertain the differences between the prior art and the claims in issue. Applicants believe that when the Examiner has reviewed the claims in view of the above amendments and remarks withdrawal of the 103 rejection will be appropriate.

Applicants respectfully submit that this application is now in condition for allowance and earnestly request such action.

If any points remain at issue which can best be resolved by way of a telephonic or personal interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Respectfully Submitted,



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